DOCKET NO: 200500US-2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:
HIDEAKI YAMANAKA, ET AL.	: EXAMINER: SHRESTHA, B.
SERIAL NO: 09/729,866	:
FILED: DECEMBER 6, 2000	: GROUP ART UNIT: 3691
FOR: DIGITAL CONTENT BILLING SYSTEM USING NETWORKS	:

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In reply to the Examiner's Answer of July 28, 2008 applicants submit the present Reply Brief.

Remarks begin on page 2 of this paper.

REMARKS

First, applicants note the Examiner's Answer contains certain erroneous paragraphs at pages 3 and 4. Specifically, under the heading "Detailed Action" the Examiner's Answer includes certain paragraphs indicating that prosecution is hereby reopened, see pages 3 and 4 of the Examiner's Answer. Those paragraphs appear to have been erroneously copied from the previous Office Action as the Examiner's Answer does not include any new grounds for rejection and does not appear to reopen prosecution in any manner.

The previously filed Appeal Brief is believed to clearly set forth applicants' position as to how the claims as written distinguish over the previously applied rejections, particularly over the outstanding rejection under 35 U.S.C. § 103 over U.S. patent application publication 2004/0073451 to Maari in view of PCT/JP00/01903 or EP 1 209 571 A1 to Nagano. The present Reply Brief thereby specifically addresses the additional statements in the "Response to Argument" set forth in the Examiner's Answer.

In maintaining the rejections of the claims as written over the applied art, the Examiner's Answer states:

> In response to appellant's arguments above, Nagano teaches advertising system and method for using electronic communication where the system uses electronic means to transmit articles in **digital form** from magazines and other and other publications to a customer (column 2, paragraph [0004]). Advertisement is, therefore, a digital content. Claims 2, 17 and 19 recites "collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user". Nagano further teaches the advertisement, a digital content, is displayed on the display device on each execution or click of mouse device by the user and advertisement fee is calculated accordingly (paragraph [0026]).
>
> Examiner further notes that teaching of Nagano is applicable to digital content containing an advertisement piece where clicking or execution of digital content results display of the said advertisement piece. Nagano's teaching is based on charging for services that corresponds to number of execution times or clicks irrespective of whether it results in display of

> digital content, digital advertisement information or any other information.[1]

In reply to the above-noted statements, the outstanding rejection is in clear error as the claims clearly recite a distinction between "digital content" and an "advertisement", and the claims clearly recite an advertisement rate is collected from an advertiser that corresponds to the number of execution times of the ***digital content used by the user, not the advertisement***.

More specifically, independent claim 2 as an example specifically recites "a holder having ***digital content***" (emphasis added) and "an advertiser possessing an ***advertising information piece*** to be provided for the user" (emphasis added). Thus, the claims clearly recite a ***distinction*** between a ***digital content*** and an ***advertising information piece***.

In the claims an advertisement rate is collected from an advertiser "that corresponds to the number of execution times of the ***digital content*** used by the user" (not based on viewing of the claimed "***advertising information piece***"). That is, the claims clearly do not recite collecting an advertisement rate based on a number of times an advertising information piece is clicked on by a user, but instead in the claims the advertisement rate is collected based on the number of execution times of the digital content, which is clearly a distinct piece of digital data from the claimed advertising information piece.

The paragraphs noted above maintaining the rejection cites Nagano on the basis that the advertisement in Nagano is equivalent to the claimed digital content. That statement is clearly erroneous. As noted above, the claims clearly recite the digital content and an advertising information piece are distinct elements, and to interpret Nagano such that the advertisement piece corresponds to the claimed digital content is clearly in error.

As discussed in the Appeal Brief in detail, Nagano discloses collecting an advertisement rate based on a number of times each advertisement is clicked on by a user,

[1] Examiner's Answer of July 28, 2008, pages 17-18 (original emphasis).

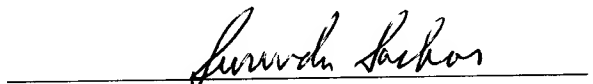
and not based on the number of times digital content to which the advertisement is added is executed by a user.

Thereby, the above-noted grounds for maintaining the rejection is clearly in error.

In view of the foregoing comments, and the comments presented in the previously filed Appeal Brief, applicants respectfully submit each of the outstanding rejections is in clear error and must be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599

Surinder Sachar
Registration No. 34,423

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)

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